

## **REMARKS**

Claims 1-88 and 90-113 are pending. Claims 26-87 are withdrawn from consideration. Claims 1-25, 88, and 90-113 are under examination. In the present amendment, Applicant proposes to amend claim 1 to recite "releasing nucleic acids from a biological sample." That amendment is supported by claim 1 as originally filed. Applicant also proposes to amend claim 1 to recite "a salt at a concentration of about 550 mM or less." That amendment is supported in the specification, for example, at page 12, line 20, through page 13, line 3; at page 29, table 3, rows 1, 2, 7, 11, 16, 18, 21, 23, and 27-30; and at page 34, lines 5-6. Applicant also proposes to amend claims 90-91, 97, 102-105, 108, and 111 to depend from claim 88, and not from claim 89, which was previously canceled in the Amendment filed February 27, 2004. The amendments do not add new matter or raise new issues. The amendments also place the application in better condition for allowance or appeal. Thus, Applicant respectfully requests entry of the amendments.

Applicant also respectfully requests that the Examiner initial and return the Form PTO 1449, which was submitted in an Information Disclosure Statement filed November 21, 2001, to indicate that the listed documents have been considered.

I. **Rejection of Claims 1, 3-6, 9-13, 15, 88, 91-94, 97-101, and 103 under 35 U.S.C. § 102(e)**

The Examiner rejected claims 1, 3-6, 9-13, 15, 88, 91-94, 97-101, and 103 under 35 U.S.C. § 102(e) as allegedly being anticipated by U.S. Patent No. 6,548,256 (Lienau). Final Office Action at page 3. Specifically, the Examiner alleges that Lienau inherently anticipates the claims, because the preamble of the claims is not limiting. *Id.* at pages 3-4.

Without acquiescing to the rejection and solely to expedite prosecution, Applicant proposes to amend claim 1 to recite that the composition comprises “a salt at a concentration of about 550 mM or less.” Lienau does not discuss a composition comprising a salt at a concentration of about 550 mM or less. In fact, Lienau’s “lysing and denaturing substance” typically contains salt at a final concentration of 2 to 4 M. See Lienau at col. 7, lines 4-7. Thus, Lienau does not anticipate claim 1.

Applicant respectfully traverses the rejection with respect to claim 88. A preamble limits a claim if it “provides antecedents for ensuing claim terms and limits the claims accordingly.” *Boehringer Ingelheim Vetmedica, Inc. v. Schering-Plough Corp.*, 65 USPQ2d 1961, 1964-65 (Fed. Cir. 2003). In claim 88, the preamble term “whole tissue, wherein the whole tissue is not blood,” provides antecedent basis for the recitation of “the whole tissue” in the body of the claim. Thus, that term limits the claim. The specification defines the term “whole tissue” as including “. . . any collection of cells organized to perform a specific function.” Specification at page 14, lines 8-9. Lienau does not teach a composition comprising “whole tissue, wherein the whole tissue is not blood” in accordance with the foregoing definition. Lienau only discusses “starting materials” comprising cultured cells or cells in a liquid suspension, such as urine, blood, or saliva. See col. 6, lines 54-57. Thus, the Examiner has failed to show that Lienau anticipates claim 88.

Because Lienau does not anticipate claim 1 or claim 88, Lienau does not anticipate claims 3-6, 9-13, 15, 91-94, 97-101, and 103, which ultimately depend from either claim 1 or claim 88. Thus, Applicants respectfully request reconsideration and

withdrawal of the rejection of claims 1, 3-6, 9-13, 15, 88, 91-94, 97-101, and 103 under 35 U.S.C. § 102(e).

**II. Objection to claims 2, 7, 8, 14, 16-25, 90, 95, 96, 102, 104-113**

The Examiner objected to claims 2, 7, 8, 14, 16-25, 90, 95, 96, 102, and 104-113 "as being dependent upon a rejected base claim . . . ." Final Office Action at page 4. As discussed above, the base claims upon which the objected claims depend are in condition for allowance. Thus, the Examiner's objection is moot. Applicant respectfully requests reconsideration and withdrawal of that objection.

**CONCLUSION**

Applicant respectfully asserts that the application is in condition for allowance. If the Examiner does not consider the application to be in condition for allowance, Applicant requests that the Examiner call the undersigned at (650) 849-6778 to arrange an interview prior to taking action.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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Dated: July 15, 2004

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